Attorney Docket No. RSW920030087US1 (7161-102U) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
Allen GILBERT, et al.	:	Confirmation Number: 1393
Application No.: 10/635,586	:	Group Art Unit: 2142
Filed: August 6, 2003	:	Examiner: C. Biagini

For: ONLINE AUTONOMIC OPERATIONS GUIDE

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated April 17, 2008.

The Examiner's response to Appellants' arguments submitted in the Appeal Brief of February 22, 2008, raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal Brief of February 22, 2008, and the arguments set forth below.

REMARKS

Prior to addressing the individual rejections, upon comparing the statement of the rejection found on pages 5-12 of the Second Office Action with the statement of the rejection found on pages 3-9 of the Examiner's Answer, Appellants have only been able to find one difference, which is the rationale for asserting that claim 4 is obvious in view of Lortz, Hopmann, and Burns (see lines 3-5 on page 7 of the Examiner's Answer). Thus, this exception aside, Appellants proceed on the basis that the Examiner's only response to Appellants' arguments presented in the Appeal Brief is found on pages 10-12 of the Examiner's Answer.

Rejection of claim 1 under 35 U.S.C. § 103

On pages 4-7 of the Appeal Brief, Appellants argued, in part, that the Examiner's cited passage in Lortz fails to teach "a request to perform an administrative task" (emphasis added). The Examiner response to these arguments is found on page 10 of the Examiner's Answer and is reproduced below:

> The Examiner submits that resource requests which require "owner" or "editor" privileges, especially in light of Appellant's indication that the level of permission associated with the request is key to proper construction, may reasonably be interpreted as "administrative tasks."
>
> Appellant further argues that "accessing a resource alone (as taught by both Lortz and Hopmann" does not disclose the claimed "administrative task." However, the Examiner again submits that since the level of permission associated with a task is key to determining whether or not it is "administrative," the "resource request" taught by Lortz meets the claim.

Appellants respectfully submit that the Examiner's response dodges Appellants' arguments, is unsupported by substantial evidence, and ignores common knowledge as to what requests are associated with an administrative task and what requests are not.

Although the Examiner refers to the claim construction proffered by Appellants, the Examiner has yet again failed to set forth an explicit claim construction for the term "administrative task." Moreover, the Examiner has failed to set forth any rationale or substantial evidence with the exception of asserting that the "level of permissions associated with the request is key to proper construction" to support the Examiner's inferred (yet unstated) claim construction. By not explicitly setting forth a claim construction, the Examiner has prevented Appellants from having the opportunity to evaluate the rationale and evidence supporting the Examiner's rationale for the Examiner's unstated claim construction.

The Examiner has also entirely misstated the comments presented by Appellants on page 6 of the Appeal Brief. Setting a level of permission, which could be considered a management/administrative task, is different than a user, with a particular level of permission, requesting a resource. Thus, the "level of permission associated with the request" is not a key to proper construction, as asserted by the Examiner.

If the Examiner's assertion that a user, with a particular level of permission, requesting a resource correctly characterized a request to perform an administrative task, then all the users would be considered administrators because all the users of Lortz have some level of permission with requesting a resource. However, as almost anyone associated with a networked computer system sharing a shared database (e.g., users accessing a document repository), the act of requesting a document (no matter the permission level) does not make the user an administrator making a request to perform an administrative task. These arguments were presented by Appellants in the Appeal Brief and were not addressed by the Examiner.

The Examiner's assertion that the teachings of Lortz correspond to the claimed "a request to perform an administrative task" is unsupported by substantial evidence. Specifically, the Examiner has failed to produce any teaching, either from Lortz or any another reference, which supports the Examiner's assertion that one having ordinary skill in the art would recognize that a client request access to a resource discloses the limitation at issue. Since the Examiner's assertion is unsupported by substantial evidence, the Examiner has failed to establish that Lortz teaches the limitations for which the Examiner is relying upon Lortz to teach.

Regarding the Examiner's obviousness analysis, Appellants presented arguments in the paragraph spanning pages 7 and 8 and in the first full paragraph on page 8 of the Appeal Brief. These arguments, however, were not addressed by the Examiner in the Examiner's Answer. Instead, the Examiner's only response is to the additional arguments presented in the paragraph spanning pages 8 and 9 of the Appeal Brief as to Hopmann failing to teach the claimed "state data for said resource." The Examiner's response is found in the paragraph spanning pages 10 and 11 of the Examiner's Answer and is reproduced below:

> Appellant further argues that Hopmann fails to teach the claimed "state data for said resource," because "[a] lock is external to the resource and does not reflect the state of the resource." The Examiner disagrees. First, nothing in the claim language requires that the state data be "internal" to the resource. Second, the lock reflects the state data of the resource in that it indicates the resource is currently being edited. In other words, resources in Hopmann have several states: unlocked, locked and inaccessible to other clients, and locked but viewable to other clients (see col. 3, line 60 to col. 4, line 2).

Similar to the limitation associated with "administrative task," the Examiner takes a well-known term-of-art, in this case "state data," and presents an (unstated) claim construction that is

not consistent with the well-known meaning of the term and unsupported by substantial evidence.

The Examiner's assertion that "nothing in the claim language requires that the state data be 'internal' to the resource" is inconsistent with the notion that the state data reflects the state of the resource. If the "state" is external to the resource, then the state is not of the resource. Instead, the state is of some entity other than the resource.

The Examiner's second assertion that "the lock reflects the state data of the resource in that it indicates the resource is currently being edited" is a factually unsupported inherency argument. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.[1] To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.[2] The fact that a resource is locked does not necessarily indicate that the resource is being edited, has been edited, or will be edited. For example, a user may request the resource but never edit the resource. Thus, one having ordinary would recognize that a resource being locked in not necessarily an indication of the state of the resource since the resource may be unchanged. Instead, the lock is an indication as to the state of other users' capabilities to access the resource.

[1] In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

[2] Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

Moreover, even if a lock could be considered as indicating that a resource is currently being edited, the Examiner has failed to establish, either with Hopmann or any other reference, that one having ordinary skill in the art would recognize that the fact a resource currently being edited is "state data," as claimed. Since the Examiner's assertion is unsupported by substantial evidence, the Examiner has failed to establish that Hopmann teaches the limitations for which the Examiner is relying upon Hopmann to teach.

Claim 4

On pages 10 and 11 of the Appeal Brief, Appellants argued that the Examiner's asserted rationale for the combining the applied prior art would not have reasonably led to the claimed invention. In response, the Examiner initially asserted the following in the first full paragraph on page 11 of the Examiner's Answer:

> Appellant argues, in connection with claim 4, that one of ordinary skill in the art would not have been motivated to retrieve state data for other related resources in a computing network when the administrative task of Lortz "does not appear to be affected by the 'other related resources' in the computing network." The Examiner notes that the claim language does not require that the retrieval of other related resources have anything to do with the nature of the administrative task. (emphasis added)

Referring to the above-underlined passage, the Examiner's assertion completely ignores the language of the claim. As recited in claim 1, upon which claim 4 depends, the administrative task is permitted based upon "said further retrieved state data." Claim 4 recites that the further retrieved state data includes state data for the resource and other related resources. Thus, the other related resources, being part of the further retrieved state data, are used to determine whether or not the administrative task is permitted.

The Examiner then asserted the following in the last full paragraph on page 11 of the Examiner's Answer:

> Burns is directed to a system which seeks out and discovers the states of a multitude of resources on a network in order to determine which resource is causing a policy to fail. For example, if the policy is that a client should have access to a specific resource, and it does not, Burns determines which network element is preventing the client from accessing the resource. The examiner submits it would have been obvious to one of ordinary skill in the art at the time the invention was made to retrieve the state data for related resources in order to determine why a policy rule was not being upheld and correct the problem if possible (see Burns, [0014]).

As referred to by Appellants earlier, these comments reflect the Examiner's newly presented obviousness analysis found in the first full paragraph on page 7 of the Examiner's Answer.

Upon reviewing paragraph [0014], Appellants are unclear where the Examiner's assertions as to the teachings of Burn are supported by paragraph [0014]. This cited passage does not appear to teach, at all, determining which resource is causing a policy to fail, as asserted by the Examiner. Thus, Appellants have been unable to confirm that Burns actually teaches what the Examiner asserts that Burns teaches in the above-reproduce passage.

Even if Burns teaches what the Examiner believes Burns teaches and one having ordinary skill in the art would have been realistically impelled to modify the applied prior art in view of Burns, the claimed invention would not result. As claimed, the other related resources, being part of the further retrieved state data, are used to determine whether or not the administrative task is permitted. However, even if Burns teaches retrieving state data of other related resources, the Examiner has failed to establish that the state data of the other related resources are being used to determine whether or not the administrative task is permitted. Instead, as alleged by the Examiner, one having ordinary skill in the art would have used state data of the other related

sources to determine why a policy rule was not being upheld, which is not comparable to the limitations at issue.

Claim 5

In response to the arguments presented by Appellants on pages 7-9 of the Appeal Brief, the Examiner asserted the following in the paragraph spanning pages 11 and 12 of the Examiner's Answer:

> Appellant further argues, in connection with claim 5, that the "configurable parameters" taught by Burns are not comparable to "a related resource having a related resource state" and said related resource state." The Examiner disagrees. In [0044], Burns teaches a network component (such as a router or firewall) being in a state which prevents packets from being transmitted to a server to which the client should have access. For example, the network component could be improperly configured, causing it to drop packets. In the combination proposed by the Examiner, the system would fail to satisfy a rule which indicates that a client should have administrative access to a resource that is not locked. The network component (such as a router or firewall) would be in a state (a state of improper configuration) that is giving rise to the failure. The system of Burns requests a remediation of the related resource state (i.e., an altering of the configuration parameters) so that the related resource state satisfies said set of rules in said retrieved policy (i.e., that the related resource state permits access to the resource). The combination would permit said administrative task subsequent to a remediation of said related resource state, as the system would have no reason to disallow the task if the related resource state were remediated. Thus, the Examiner submits that the combination presented above meets the limitations of the claim.

As claimed, the administration policy comprises a set of rules for governing the administrative task. Referring to claim 5, the administrative task is disallowed if the further retrieved state data fails to satisfy the policy. However, the teachings of paragraph [0044] are completely unrelated to the limitations at issue. Burns teaches reconfiguring network elements to make the network conformant with a policy statement. Also, the policy of Burns is a security policy (see, e.g., paragraphs [0006], [0011], [0017]), which is not comparable to the claimed administration policy. Moreover, Appellants are unclear as to why one having ordinary skill in the art would write into a policy, which governs an administrative task, rules associated with

whether or not certain resources can be reconfigured after a security policy has not been met, as taught by Burns.

For the reasons set forth in the Appeal Brief of February 22, 2008, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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